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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,148	03/31/2000	Peter T Fry	80934F-P	1747

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EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/540,148

Applicant(s)

FRY ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-17, 20-27, 30 and 40-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-17, 20-27, 30 and 40-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to the Applicants' amendment filed on May 31, 2005. Claims 1-7, 10-17, 20-27, 30, and 40-76 are pending and will be considered for examination.

Final Rejection

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1-7, 11-17, 21-27, 40-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoekstra et al. (US 6,304,277 B1) hereinafter referred to as Hoekstra.

Referring to claims 1-7, 11-17, 21-27, 40-76, Hoekstra discloses a method and system comprising the steps of: a user obtaining a low-resolution digital image file, a high-resolution digital image file, and associated meta data of an image (column 4, lines 7-31; Figure 1, item "10"; column 8, line 39-64; Figure 4, item "320"); transmitting said low resolution digital image file and said associated meta data which contains information about the digital image file by said user from a first location to a server at a remote image photoservice provider at a second location over said communication network, said server having software for manipulating said image file (column 2, line 33

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– column 3, line 15; column 5, lines 23-28). Hoekstra does not teach that the meta data contains information about the high-resolution digital image file. However, the Examiner notes that this limitation is not functionally involved in the steps or elements of the recited method or system. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps and elements would be the same regardless of what information the meta data contained. The differences between the content of the Applicants' data and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the meta data of Hoekstra because such information does not functionally relate to the steps or elements of the claimed method or system and because the subjective interpretation of information does not patentably distinguish the claimed invention. Hoekstra does not disclose that the user uses the software on the server at the first/second locations. However, Hoekstra discloses that it is well known in the art for an automated script file (i.e. software) at the second location to perform modifications on an image file (column 1, line 58 – column 2, line 5). Hoekstra further discloses that these automated script files fail to accurately correct all problems because not all files require the same corrections (column 2, lines 6-8). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the user edit the script file (i.e. use the software) at the

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second location. One of ordinary skill in the art would have been motivated to do so in order to allow the user to customize the script file to the particular characteristics of his or her individual image files. Hoekstra does not disclose transmitting the high-resolution digital image file after using the software for fulfillment of said goods or services.

However, Hoekstra discloses that it is well known in the prior art to transmit a high-resolution digital image file for commercial purposes (column 1, lines 19-35; column 2, lines 18-23). Furthermore, Hoekstra discloses that once the high-resolution digital image file on the user's computer has been modified, it is "...then ready for use as desired." (column 6, lines 31-38). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the user in the invention of Hoekstra transmit the high-resolution digital image file to a second location.

One of ordinary skill in the art would have been motivated to do so in order to allow the user to perform various commercial activities such printing as disclosed by Hoekstra.

Finally, Hoekstra discloses that the terms "high resolution" and "low resolution" are relative. Hoekstra discloses that the high resolution and low-resolution files referred to may vary greatly in size and in some instances overlap (low-resolution image is not greater than 200 x 150, where the high res is no less than 780 x 560, where low res is no greater than 50% of high resolution image) (column 4, lines 32-51).

Claims 10, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoekstra et al. U.S. Patent No. 6,304,277, as applied in claims 1, 11, and 21, in view of Hopkins U.S. Patent No. 6,282,462.

Hoekstra et al. does not explicitly disclose that the transmission of high-resolution image may be interrupted and resumed at the same place where transmission was Interrupted. Hopkins shows a method for consistent transmission of image data preventing data loss (Co1 3, Line 611. Given the unreliability of communications' networks it would have been obvious to modify the system of Hoekstra et al. to provide consistent transmission of image data, as taught by Hopkins, in order to maintain customer satisfaction and prevent any frustration involved at having to restart the image transmission process.

Response to Arguments

The corrected drawings filed on May 31, 2005 are sufficient to overcome the objection in the previous Office Action. This objection is withdrawn.

Applicants' arguments with respect to the rejection of claims 1, 11, 21, 40, and 50 under 35 USC §112 first paragraph have been fully considered and are persuasive. This rejection is withdrawn.

Applicants' arguments with respect to the rejection of claims 1, 11, 21, 40, and 50 under 35 USC §112 second paragraph have been fully considered and are persuasive. This rejection is withdrawn.

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Applicants' arguments with respect to the rejection of claims 1-7, 11-17, 21-27, and 40-76 under 35 USC §103(a) have been fully considered but they are not persuasive. The Applicants have argued that Hoekstra does not teach or suggest transmitting a low-resolution image file of an image to a remote location of a service provider and wherein software is provided for manipulation of the image file. The Examiner respectfully disagrees. Hoekstra clearly states the following:

"In accordance with a broad aspect of the present invention, a method is provided for modifying a digital image file. The method comprises the steps of: (a) electronically transferring from a first location to a second location a compressed low resolution proxy file representing a high resolution digital image...(c) performing one of a plurality of image correction modifications on the restored low resolution proxy file..." (col. 2, lines 33-42).

The "image correction modifications" of Hoekstra correspond to the Applicants' "manipulation".

The Applicants' have also argued that Hoekstra does not teach or suggest uploading a high-resolution image file. The Examiner respectfully disagrees with this argument because Hoekstra provides the suggestion and motivation for this limitation. Hoekstra discloses that it well known in the art to transmit a high-resolution digital image file for commercial purposes such as printing (col. 1, lines 19-41). Furthermore, Hoekstra discloses that the terms "high resolution" and "low resolution" are relative and in some instances overlap (column 4, lines 32-51). Therefore, since the Applicants have not explicitly provided a definition for the term "high resolution", Hoekstra's "low

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resolution” can be construed by one of ordinary skill in the art as reading on the Applicants’ “high resolution” image.

Finally, the Applicants have argued that the Examiner’s treatment of the contents of the meta data as non-functional descriptive material is improper because the independent claims use the particular content during the feed back step (i.e. “...providing feed back to said user based in said meta data...”). The Examiner respectfully disagrees with this argument because the step of providing feed back is written in the alternative form (i.e. “and/or”). Therefore, since the Examiner has addressed the second option of the alternative language, there is no requirement for the Examiner to address the option of “...providing feed back to said user based in said meta data...”

For these reasons, the Examiner maintains the art rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
Art Unit 3625

November 2, 2005



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